

## **REMARKS**

### **Amendments to the Claims**

Claims 1-3, 7, 9-16, 19, 21-27, 30, 31, 33-35 have been amended to clarify the language used in the claims in light of the recent Federal Circuit decision in *SuperGuide Corp. v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004). The Applicants submit that no new matter has been added by these amendments.

Claim 6 been amended to clarify the language used in the claim in light of the recent Federal Circuit decision in *SuperGuide Corp. v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004), and to correct a minor typographical error. The Applicants submit that no new matter has been added by these amendments.

### **Rejection of Claims**

Claims 1-35 are pending in the application, and were rejected in the Office action of August 9, 2005. Claims 1, 14, 27, and 30 are independent claims. Claims 2-13, 15-26, 28-29, and 31-35 depend either directly or indirectly from independent claim 1, 14, 27, and 30, respectively. The Applicants request reconsideration of the pending claims 1-35, in light of the following remarks.

Claims 1-35 were rejected under 35 U.S.C. 103(a) as being unpatentable under *Mikami et al.* [U.S. Patent 5,704,031 hereinafter “Mikami”] in view of *Faust et al.* [U.S. Pub. Appl. 2002/0124209 hereinafter “Faust”]. The Applicants respectfully traverse the rejection.

With regard to an obviousness rejection, MPEP 2142 states that in order for a prima facie case of obviousness to be established, three basic criteria must be met, one of which is that the reference or combination of references must teach or suggest all the claim limitations. Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination”, and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so’” (citing *In re Mills*, 916 F. 2d 680, 16 USPQ 2d 1430 (Fed Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the

suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F. 3d 1308, 50 USPQ 2d. 1161 (Fed Cir. 1999).

Regarding amended claim 1, the Applicants respectfully submit that the proposed combination of Mikami and Faust does not teach, suggest, or disclose, for example, an updatable electronic device comprising a memory having at least one of the following: firmware and software; a first firmware component for determining the occurrence of at least one of the following: an error and an exception during the execution of the at least one of the following: firmware and software; a second firmware component for gathering at least one parameter related to the occurrence of the at least one of the following: an error and an exception; interface circuitry for receiving update information via a communication network, the update information based upon the at least one parameter; and a third firmware component for applying the update information to at least a portion of the at least one of the following: firmware and software. The Applicants appreciate recognition in the Office action that “Mikami does not explicitly teach first, second, and third firmware components.” (Office action, page 4) The Applicants respectfully submit that Mikami fails to teach anything in regard to firmware performing the functions recited in Applicants’ claim 1, in any of the disclosed elements. More specifically, Mikami fails to disclose a firmware component for applying update information to at least a portion of at least one of the following: firmware and software. The Office action asserts that “Mikami explicitly used multiple servers as firmware components to perform data gathering, error detection, and information updating as illustrated therein.” (Office action, page 5) The Applicants respectfully disagree. A server is different from and fails to teach an updatable electronic device comprising the firmware components of Applicants’ claim 1.

The Applicants respectfully submit that Faust also fails to teach, suggest, or disclose a firmware component for applying update information to at least a portion of at least one of the following: firmware and software. Instead, Faust simply stores in memory information related to a fault. (page 3, pars. [0033], [0034]) Faust fails to teach anything in regard to updating.

The Applicants respectfully submit, therefore, that the proposed combination of the Mikami and Faust references fails to teach all of the limitations of Applicants’ claim 1, that the Office action has not established a *prima facie* case of obviousness, and that a rejection of claim 1 under 35 U.S.C. §103(a) cannot be maintained.

Therefore, the Applicants respectfully submit that claim 1 is allowable over the proposed combination of the Mikami and Faust references, for at least the reasons set forth above.

Applicants respectfully submit that claim 1 is an independent claim, and that claims 2-13 depend either directly or indirectly from claim 1. Applicants respectfully submit, therefore, that claims 2-13 are allowable over the proposed combination of references, as well. Therefore, the Applicants respectfully request that the rejection of claims 1-13 under 35 U.S.C. §103(a) be withdrawn.

Regarding amended claim 14, the Applicants respectfully submit that the proposed combination of Mikami and Faust does not teach, suggest, or disclose, for example, a method of operating an updatable electronic device comprising a memory containing at least one of the following: firmware and software, the method comprising determining whether at least one of the following: an error and an exception has occurred; continuing regular processing if the at least one of the following: an error and an exception has not occurred; generating an identifier based upon at least one parameter, if the at least one of the following: an error and an exception has occurred; receiving, via a communication network, update information based upon the identifier; and updating at least a portion of the at least one of the following: firmware and software using the update information. The rejection of claims 14-26 as set forth in the Office action refers only to the reasons set forth in the rejection of claims 1-13, and fails to provide any additional grounds for rejection. Applicants respectfully submit that claims 14-26 are allowable over the proposed combination of Mikami and Faust, for at least the same reasons set forth above with respect to claims 1-13. In addition, both the Mikami and Faust references fail to teach, suggest, or disclose, for example, generating an identifier based upon at least one parameter, if at least one of the following: an error and an exception has occurred, and receiving, via a communication network, update information based upon the identifier. Instead, Mikami stores error information in an error information file, that is later collected and analyzed by a separate management unit. (Fig. 1; col. 5, ll. 1-10; col. 6, ll. 11-24) No specific teaching of Mikami has been identified that relates to the generation of an identifier, or of receiving, via a communication network, update information based upon such an identifier.

Applicants respectfully submit that Faust also fails to teach, for example, generating an identifier based upon at least one parameter, if at least one of the following: an error and an exception has occurred, and updating at least a portion of at least one of the following: firmware and software using update information. Instead, Faust teaches "...an improved method, apparatus, and

computer implements instructions for saving data, such as system dump data and error logs.” (page 3, par. [0033]) Faust also teaches that error analysis may be performed upon the stored dump data and error logs. (page 4, par. [0040]) However, the Office action fails to specifically identify any teaching of Faust with respect to generating an identifier, and receiving update information based upon such an identifier.

The Applicants respectfully submit, therefore, that the proposed combination of the Mikami and Faust references fails to teach all of the limitations of Applicants’ claim 14, that the Office action has not established a *prima facie* case of obviousness, and that a rejection of claim 14 under 35 U.S.C. §103(a) cannot be maintained.

Therefore, the Applicants respectfully submit that claim 14 is allowable over the proposed combination of the Mikami and Faust references, for at least the reasons set forth above and those set forth with respect to claims 1-13. Applicants respectfully submit that claim 14 is an independent claim, and that claims 15-26 depend either directly or indirectly from claim 14. Applicants respectfully submit, therefore, that claims 14-26 are allowable over the proposed combination of references, as well. Therefore, the Applicants respectfully request that the rejection of claims 14-26 under 35 U.S.C. §103(a) be withdrawn.

Regarding amended claim 27, the Applicants respectfully submit that the proposed combination of Mikami and Faust does not teach, suggest, or disclose, for example, a method of operating an updatable electronic device, the method comprising determining that at least one of the following: a firmware and a software error has occurred; gathering at least one parameter related to the at least one of the following: a firmware and a software error; identifying update information for correcting the at least one of the following: a firmware and a software error; receiving the update information via a communication network; and updating at least one of the following: firmware and software using the update information.. The rejection of claim 27 as set forth in the Office action states that “[d]ue to the similarity of the claims 27-29 to claims 1, 5, and 9 except for a **method** of operating an updatable electronic device comprising steps of determining the occurrence errors [sic], gathering parameter [sic], updating information, etc... instead of **updatable electronic device** comprising a first component for determining the occurrence errors [sic], second component for gathering parameter [sic], a third component for updating information, etc... Therefore, these claims are also rejected under the same rationale applied against claims 1, 5 and 9.” (Office action, page

16) The Office action refers only to the reasons set forth in the rejection of claims 1, 5 and 9, and fails to provide any additional grounds for rejection. Therefore, applicants respectfully submit that claim 27 is allowable, for at least the reasons set forth above with respect to claim 1.

Therefore, the Applicants respectfully submit that claim 27 is allowable over the proposed combination of the Mikami and Faust references, for at least the reasons set forth above and those set forth with respect to claim 1. Applicants respectfully submit that claim 27 is an independent claim, and that claims 28 and 29 depend from claim 27. Applicants respectfully submit, therefore, that claims 28 and 29 are allowable over the proposed combination of references, as well. Therefore, the Applicants respectfully request that the rejection of claims 27-29 under 35 U.S.C. §103(a) be withdrawn.

Regarding amended claim 30, the Applicants respectfully submit that the proposed combination of Mikami and Faust does not teach, suggest, or disclose, for example, a network for updating at least one of the following: firmware and software in at least one updatable electronic device, the network comprising at least one server receiving at least one of the following: device characteristics and an error report from the at least one updatable electronic device, the at least one server retrieving appropriate update information based on the at least one of the following: device characteristics and an error report; the server communicating the update information to the at least one updatable electronic device using a wireless interface; and the at least one updatable electronic device using the update information to update the at least one of the following: firmware and software. The rejection of claim 30 as set forth in the Office action states that “[d]ue to the similarity of claims 30-35 to claims 1-4 and 9 except for a network for updating updatable electronic device comprising server for reporting errors, server receiving information, server for updating information, etc... instead of updatable electronic device comprising a first component for determining the occurrence errors [sic], second component for gathering parameter [sic], a third component for updating information,, etc...Mikami explicitly teaches a plurality of servers connected to support the hardware, software, and firmware error detection and correction system [fig. 1, col. 3, lines 60 through col. 4, lines 2]; Therefore, these claims are also rejected under the same rationale applied against claims 1-4 and 9.” (Office action, page 17) The Office action refers only to the reasons set forth in the rejection of claims 1-4 and 9, and fails to provide any additional

grounds for rejection. Therefore, Applicants respectfully submit that claim 30 is allowable, for at least the reasons set forth above with respect to claim 1.

Therefore, the Applicants respectfully submit that claim 30 is allowable over the proposed combination of the Mikami and Faust references, for at least the reasons set forth above and those set forth with respect to claim 1. Applicants respectfully submit that claim 30 is an independent claim, and that claims 31-35 depend either directly or indirectly from claim 30. Applicants respectfully submit, therefore, that claims 31-35 are allowable over the proposed combination of references, as well. Therefore, the Applicants respectfully request that the rejection of claims 30-35 under 35 U.S.C. §103(a) be withdrawn.

### Conclusion

The Applicants believe that all of claims 1-35 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to contact the undersigned at (312) 775-8000 for an interview.

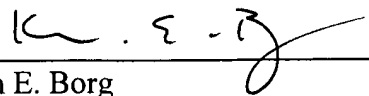
A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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